

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 2-10, 13-17 and 20-30 are now present in this application. Claims 2, 4, 7, 8, 10, 13, 14, 20 and 29 are independent.

Amendments have been made to claims 2, 3, 4, 7, 8-10 and 13-17. Claims 1, 11-12, 18-19 are canceled, and claim 30 is added. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Restriction/Election Requirement

The Examiner has made the Restriction/Election Requirement final, and has withdrawn claims 20-28 from further consideration. This Amendment clearly indicates the status of claims 20-28 as being withdrawn from consideration.

Claim Objections

The Examiner has objected to the claims because there are two claims with the same number. The Examiner has renumbered claims 1 to 11 (first occurrence) and 11 (second occurrence) to 28 as claims 1-29. Applicant thanks the Examiner for doing this, and has reflected this renumbering of claims in the amendments to the claims, thereby overcoming the objection.

Reconsideration and withdrawal of this objection are respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1, 3, 5, 6, 11, 12 and 16-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,319,363 to Welch et al. ("Welch"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

This rejection is moot with respect to claims 1, 11, 12, 18 and 19, which have been canceled.

Claims 3, 5 and 6, as amended, depend from claim 2. Since claim 2 was not rejected under 35 U.S.C. § 102(b), this rejection as it applies to claims 3, 5 and 5 and 6 has been rendered moot.

Claims 16 and 17, as amended, depend from claim 13. Since claim 13 was not rejected under 35 U.S.C. § 102(b), this rejection as it applies to claims 16 and 17 has been rendered moot.

Reconsideration and withdrawal of this rejection of claims 1, 3, 5, 6, 11, 12 and 16-19 are respectfully requested.

Rejections under 35 U.S.C. §103

Claims 2, 4, 7-10, 13-15 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Welch in view of "Official Notice that in the alarm communication art, use of alarm systems including audible and visual alarms that are controlled so as to be varied in tone, volume, intensity, etc., at a user's discretion is well known." This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital

Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Initially, Applicants note the decision in In re Boon, 169 USPQ 231 (CCPA 1971), which points out that the Office must provide a specific reference, such as a dictionary, in support of the grounds used to reject a claim and, in this regard, states that the Office may not take official notice of factual grounds for a rejection unless those facts (1) are supported by a standard reference work and (2) play a minor role, i.e., serving only to fill in gaps in the Office's evidentiary showing in support of a particular ground for rejection.

In this rejection, the Office has not presented a standard reference work to support the facts with respect to which official notice has been taken, nor do the facts with respect to which official notice has been taken play a minor role in the rejection. In fact, the facts with respect to which official notice has been taken from an essential part of this rejection. Because of this, the rejection is fundamentally improper and cannot make out a *prima facie* case of obviousness of the claimed invention. More recent case law, such as the "In re Lee" decision, cited above, reinforce the holding in the "Boon" decision by requiring that the Office provide objective factual evidence in support of a rejection, not just a speculative conclusion supported only by an assertion of "official notice" that has no specific reference work (like a dictionary) cited to support it.

Additionally, because Welch discloses such a comprehensive system, Applicant respectfully submits that if providing the recited features set in claim 3 were so obvious, then Welch would have

thought of doing so, and disclosed such features in the Welch patent application, when the application was filed in 1992. However, Welch is totally silent in this regard. This is an indication that Applicant's claimed combination of features is not obvious to one of ordinary skill in the art.

Claim 2 positively recites a combination of features wherein each of said plurality of speakers is volume controlled to be independently adjusted to cause the audible alarm to have a substantially constant volume level throughout a specified work area of the building. This combination is not disclosed by Welch. Welch never addresses this subject matter and, instead relies on annunciators that combine sound and a message – see col. 6, lines 1-15, for example. Applicant is unable to find in Welch, a disclosure that each of said plurality of speakers is volume controlled to be independently adjusted to cause the audible alarm to have a substantially constant volume level throughout a specified work area of the building, as recited.

Further, with respect to claim 4, which has been written in independent form and amended to recite that the audible alarm is provided with several different tones, volumes, chimes and sounds, Welch does not disclose or suggest this feature by itself; the “official notice” rejection basis is without merit at least for the reasons stated above, and the “official notice” rejection basis does not address this combination of features, that includes an audible alarm provided with several different tones, volumes, chimes and sounds.

Further, with respect to claim 7, Welch does not discuss a battery backup at all, which is a positively recited feature of claim 7, and the “official notice” basis for the rejection does not even mention this feature, let alone any basis for providing different tones and/or volume for a low battery backup condition. Nor is the rejection proper to the extent that it relies on the taking of official notice, for the reasons discussed above.

Further, with respect to claims 8-10 and 15, Welch clearly does not disclose or suggest the recited pitch or tone changes, or increase in volume over time as the audible alarm continues, and the “official notice” basis for this rejection is improper, for the reasons stated above.

Further, with respect to claim 13, Welch clearly does not disclose or suggest the recited blink feature or frequency increase feature, and the “official notice” basis for this rejection is improper, for the reasons stated above.

Further, with respect to claim 14, Welch clearly does not disclose or suggest the claimed light intensity increase over time as a visual alarm continues, and the “official notice” basis for this rejection is improper, for the reasons stated above.

Further, with respect to claim 15, Welch has no disclosure of blinking light sources, or of changing the frequency of the blink frequency, and the “official notice” basis for the rejection is improper for reasons presented above.

Further, with respect to claim 29, Welch discloses suspending the alarm by providing a “suspend alarm” button 114 on the console located at the nurse’s work station (col. 10, lines 48-65) or by using a set of physical keys or buttons arranged at numerous locations throughout the floor, or the health care provider may carry an infrared emitter, the keys, buttons and infrared emitter being linked to the workstation to disable an alarm (col. 11, lines 4-11). These options are significantly different than what is recited in claim 29. Claim 29 positively recites a combination of features, including (1) an adaptor connecting one of said plurality of medical condition monitoring units to said control unit of said monitoring system. None of Welch’s buttons or keys nor its infrared emitter, is explicitly disclosed as even being connected to the monitoring unit, let alone connecting the monitoring unit to the control unit of the monitoring system, as recited. Nor is

this positively recited feature inherently, i.e., necessarily (not just possibly and not just probably) disclosed in Welch. Welch only discloses buttons or keys or an IR remote connected to a control unit.

Because there is no objective factual evidence presented of an adaptor unit connecting one of the plurality of medical condition monitoring units to a control unit of the monitoring system, the only basis for this rejection must be either improper speculation or impermissible hindsight reconstruction of Applicant's invention based solely on Applicant's disclosure.

Claim 29 continues by reciting that the adaptor includes (a) an input terminal for connection to an alarm output of one of said plurality of medical condition monitoring units; (b) an output terminal for connection to said control unit; and (c) circuitry including a switch, wherein in a first switch position, an alarm condition present at said alarm output of said one of said plurality of medical condition monitoring units is substantially immediately passed to said output terminal, and wherein in a second switch position, an alarm condition present at said alarm output of said one of said plurality of medical condition monitoring units is suppressed, as recited. Welch merely discusses its suppression tools (buttons, keys, IR remote) as being connected to the work station. Welch is devoid of a teaching of an adaptor connected between the monitoring units and its control unit and functioning as recited. The Office Action fails to provide any objective evidence of the existence of the claimed adaptor connected between a controller and monitoring devices in Welch or any other reference, and fails to explain why it would be obvious to modify Welch to include such a feature. Instead, the Office Action merely speculates that it would be obvious to jump from Welch's buttons, keys and IR remote connected only to its controller to modifying Welch by providing the claimed adaptor connected between

the controller and monitoring devices instead of providing objective factual evidence in support of its speculative conclusion.

Accordingly, the Office Action fails to make out a prima facie case of proper motivation to modify Welch, as suggested, and fails to make out a prima facie case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection are respectfully requested.

New Claim 30

Claim 30 has been added for the Examiner's consideration. Applicant submits that claim 30 depends from independent claim 2, and is therefore allowable based on its dependence from claim 2 which is believed to be allowable for the reasons stated above.

In addition, claim 30 recites further limitations which are not disclosed or made obvious by the applied prior art references.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently

outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

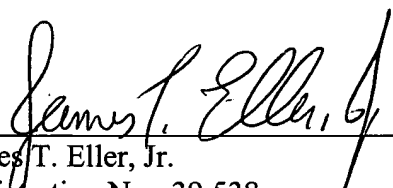
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested. If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

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Respectfully submitted,

SLL/JTE/RJW/cm/kmr/cdr

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